

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE PTO/SB/17 (12-04)

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<b>FEE TRANSMITTAL</b> <b>for FY 2005</b> Patent fees are subject to annual revision. Effective December 8, 2004	<b>Complete if Known</b>	
	Application Number	09/931,358
	Confirmation Number	3584
	Filing Date	August 16, 2001
	First Named Inventor	Russell Charles Dodd
	Examiner Name	Andrew J. Fischer
TOTAL AMOUNT OF PAYMENT (\$500)		Art Unit 3627
		Attorney Docket No. 8677

<b>METHOD OF PAYMENT</b> 1. [X] The Director is hereby authorized to charge indicated fees submitted on this form, credit any over payments, and charge any additional fee(s) during the pendency of this application to: Deposit Account Number: 16-2480 Deposit Account Name: The Procter & Gamble Company		<b>FEE CALCULATION (continued)</b> <b>5. ADDITIONAL FEES</b> <table border="1"> <thead> <tr> <th>Fee Description</th> <th>Fee Paid</th> </tr> </thead> <tbody> <tr> <td>Extension for reply within 1<sup>st</sup> month</td> <td>(\$120) <input type="checkbox"/></td> </tr> <tr> <td>Extension for reply within 2<sup>nd</sup> month</td> <td>(\$450) <input type="checkbox"/></td> </tr> <tr> <td>Extension for reply within 3<sup>rd</sup> month</td> <td>(\$1,020) <input type="checkbox"/></td> </tr> <tr> <td>Extension for reply within 4<sup>th</sup> month</td> <td>(\$1,590) <input type="checkbox"/></td> </tr> <tr> <td>Extension for reply within 5<sup>th</sup> month</td> <td>(\$2,160) <input type="checkbox"/></td> </tr> <tr> <td>Information Disclosure Statement fee</td> <td>(\$180) <input type="checkbox"/></td> </tr> <tr> <td>37 CFR 1.16(e) Late Oath/Declaration (nonprovisional)</td> <td>(\$130) <input type="checkbox"/></td> </tr> <tr> <td>37 CFR 1.17 (q) Missing Parts (provisional)</td> <td>(\$50) <input type="checkbox"/></td> </tr> <tr> <td>Non-English specification</td> <td>(\$130) <input type="checkbox"/></td> </tr> <tr> <td>Notice of Appeal</td> <td>(\$500) <input type="checkbox"/></td> </tr> <tr> <td>Filing a brief in support of an appeal</td> <td>(\$500) [500]</td> </tr> <tr> <td>Request for oral hearing</td> <td>(\$1,000) <input type="checkbox"/></td> </tr> <tr> <td>Acceptance of unintentionally delayed claim for priority under 35 U.S.C. 119, 120, 121, or 365 (a) or (c)</td> <td>(\$1,370) <input type="checkbox"/></td> </tr> <tr> <td>Other:</td> <td><input type="checkbox"/></td> </tr> </tbody> </table>		Fee Description	Fee Paid	Extension for reply within 1 <sup>st</sup> month	(\$120) <input type="checkbox"/>	Extension for reply within 2 <sup>nd</sup> month	(\$450) <input type="checkbox"/>	Extension for reply within 3 <sup>rd</sup> month	(\$1,020) <input type="checkbox"/>	Extension for reply within 4 <sup>th</sup> month	(\$1,590) <input type="checkbox"/>	Extension for reply within 5 <sup>th</sup> month	(\$2,160) <input type="checkbox"/>	Information Disclosure Statement fee	(\$180) <input type="checkbox"/>	37 CFR 1.16(e) Late Oath/Declaration (nonprovisional)	(\$130) <input type="checkbox"/>	37 CFR 1.17 (q) Missing Parts (provisional)	(\$50) <input type="checkbox"/>	Non-English specification	(\$130) <input type="checkbox"/>	Notice of Appeal	(\$500) <input type="checkbox"/>	Filing a brief in support of an appeal	(\$500) [500]	Request for oral hearing	(\$1,000) <input type="checkbox"/>	Acceptance of unintentionally delayed claim for priority under 35 U.S.C. 119, 120, 121, or 365 (a) or (c)	(\$1,370) <input type="checkbox"/>	Other:	<input type="checkbox"/>
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3. <b>APPLICATION SIZE FEE:</b> Sheets of Spec and Drawings <input type="checkbox"/> (\$250 for each 50 sheets in excess of 100, except for sequence and program listings) SUBTOTAL (2)+(3) (\$11)																																	
4. <b>EXTRA CLAIM FEES FOR UTILITY AND REISSUE:</b> <table border="1"> <thead> <tr> <th></th> <th>Extra Claims</th> <th>Fee from Below</th> <th>Fee Paid</th> </tr> </thead> <tbody> <tr> <td>Total Claims <input type="checkbox"/> - 20** = <input type="checkbox"/> x</td> <td><input type="checkbox"/></td> <td>=</td> <td><input type="checkbox"/></td> </tr> <tr> <td>Independent Claims <input type="checkbox"/> - 3** = <input type="checkbox"/> x</td> <td><input type="checkbox"/></td> <td>=</td> <td><input type="checkbox"/></td> </tr> <tr> <td>Multiple Dependent claims:</td> <td><input type="checkbox"/></td> <td>=</td> <td><input type="checkbox"/></td> </tr> </tbody> </table> ** or number previously paid, if greater; For Reissues, see below <b>Fee Description</b> Claims in excess of 20 (\$50 per claim) Independent claims in excess of 3 (\$200 per claim) Multiple dependent claim, if not paid (\$360) **Reissue: each independent claim over 3 and more than in the original patent (\$200 per claim) **Reissue claims: each claim over 20 and more than original patent (\$50 per claim) SUBTOTAL (4) (\$11)			Extra Claims	Fee from Below	Fee Paid	Total Claims <input type="checkbox"/> - 20** = <input type="checkbox"/> x	<input type="checkbox"/>	=	<input type="checkbox"/>	Independent Claims <input type="checkbox"/> - 3** = <input type="checkbox"/> x	<input type="checkbox"/>	=	<input type="checkbox"/>	Multiple Dependent claims:	<input type="checkbox"/>	=	<input type="checkbox"/>																
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<b>SUBMITTED BY</b>		<b>Complete (if applicable)</b>	
Name (Print/Type)	Matthew P. Fitzpatrick	Registration No.	41,751
Signature	<i>Matthew P. Fitzpatrick</i>	(Attorney/Agent)	
		Telephone	(513) 634-4287
		Date	5/23/05

This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application, Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon individual case. Any comments on the amount of time you are required to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P. O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Number of Pages Including this Page: <sup>19</sup>~~18~~

- 1) Fee Transmittal (1 page)
- 2) Appeal Brief (17 pages)
- 3)
- 4)
- 5)

Inventor(s): Russell Charles Dodd

S.N.: 09/931,358

Filed: August 16, 2001

Docket No.: 8677

Comments:

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Matthew Fitzpatrick 41,751  
Name Registration No. (if applicable)  
*Matthew Fitzpatrick*  
Signature  
May 23, 2005  
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/931,358  
Applicant(s) : RUSSEL CHARLES DODD  
Filed : August 16, 2001  
Titled : CUSTOMIZED CUSTOMER PORTAL  
TC/A.U. : 3627  
Examiner : Andrew J. Fischer  
Confirmation No. : 3584  
Docket No. : 8677  
Customer No. : 27752

APPEAL BRIEF

Mail Stop Appeal Briefs – Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir,

This Brief is filed pursuant to the appeal from the U.S. Patent and Trademark Office Final Office Action dated December 23, 2004. A timely notice of Appeal was filed on February 23, 2005.

REAL PARTY IN INTEREST

The real party in interest is the Procter & Gamble Company of Cincinnati, Ohio.

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### RELATED APPEALS AND INTERFERENCES

There are no known related appeals, interferences, or judicial proceedings.

### STATUS OF CLAIMS

Claims 1 – 9 and 14 are pending and stand rejected. Claims 1 – 9 and 14 are being appealed. A complete copy of the appealed claims is set forth in the Claims Appendix attached herein.

### STATUS OF AMENDMENTS

No amendment was filed subsequent to the appealed from Final Action of December 23, 2004.

### SUMMARY OF THE CLAIMED SUBJECT MATTER

Claim 1 relates to a method of providing a customized customer portal (Page 1, Title; Page 4, lines 20 – 21; Fig. 1).

The method involves providing an interface to a plurality of customers. (page 7, lines 5-15, Fig. 1). Both the claims and the specification expressly define that customers are purchasers of goods for subsequent sale to consumers. (page 4, line 20 – page 5, line 10). The term “goods” is also expressly defined in the specification and distinguished from services, intangibles, and real property (page 5, lines 19-34).

The method also involves receiving customer identification information from at least one of the customers such receipt being through the use of the interface. (page 7, lines 5-15; Fig. 1).

The method also involves receiving from the customer an indication of purchase interest in a consumer product, selected from among a plurality of such products available for sale. The identity of the consumer products is made known through the interface. (page 7, lines 15-30; Fig. 1).

The method involves accessing customer information from a pre-existing database. (page 7, line 5-15; Fig. 1).

The method also involves providing information pertaining to the selected consumer product to the customer. This information is customized on the basis of the

customer information previously accessed. Additionally, at least some of the information includes consumer sales projection information calculated with respect to the customer (i.e. a projection of the sales the buyer/user of the system will make to others). (page 8, lines 14-25; page 11, lines 15-33).

#### GROUND OF REJECTION TO BE REVIEWED ON APPEAL

I. Claims 1-9 and 14 stand rejected as obvious under 35 U.S.C. § 103 over Roberts et al. (US Patent 6,101,486) in view of Brockman et al. (US Patent 5,826,240).

II. Claims 1-9 and 14 stand rejected as anticipated under 35 U.S.C. § 102(e) by Peterson et al. (US Patent No. 6,324,522).

III. Claims 1-9 and 14 stand rejected as obvious under 35 U.S.C. § 103 as obvious over Peterson et al. (US Patent No. 6,324,522).

IV. Claims 1 – 9, and 14 stand rejected as indefinite under 35 U.S.C. § 112, second paragraph.

#### ARGUMENT

##### **I. THE REJECTION OF CLAIMS 1-9 AND 14 UNDER 35 U.S.C. § 103 OVER ROBERTS ET AL IN VIEW OF BROKMAN ET AL IS IMPROPER.**

The final office action does not make out a proper § 103 rejection of Claims 1 – 9 and 14 over Roberts et al. in view of Brockman et al. because the rejection is premised upon an incorrect claim construction which ignores express definitions of key claim terms. As such, the Final Action has failed to establish a *prima facie* case of obviousness.

##### **Claim Construction – Lexicography Dispute**

During proceedings before the U.S. Patent and Trademark Office, pending claims must be given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). MPEP 211.01 While there is a presumption that claim terms are to be given their plain and ordinary meaning, it is well-settled that an applicant is entitled to be his or her own lexicographer by clearly setting forth a definition of the term that is different from its ordinary and customary meaning. In re Paulsen, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of that term as it is used in the claim. Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999). Such definitions must be clear, and it is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language. In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970).

In the instant case, the Examiner has made a factual finding that the Applicant has decided not be his own lexicographer (see e.g., Final Action, Para. 13). This finding is contrary to both the prosecution record and the law. Pages 4, line 20 through page 5 line 34 of the specification as originally filed provide express definitions of *inter alia* the terms "customer" and "consumer." The Applicant has consistently and repeatedly cited these definitions and relied on them throughout prosecution. (Response filed Feb. 4, 2003, page 2 "As the applicant has chosen to be his own lexicographer with respect to terms such as 'customer,' 'consumer,' and 'goods,' these definitions must be used for examination of the claims."; Amendment filed September 11, 2003, page 4 "Claim 1 has been amended . . . to clarify the meaning of the term 'customer' as defined in the instant specification."; Response filed November 14, 2003 page 2 reiterating that September 11, 2003 amendment expressly recites that the customer is a purchaser of goods for subsequent re-sale to consumers; Response filed September 22, 2004 page 3 "The applicant was expressly intending to be his own lexicographic [sic] insofar as the express definitions of claim terms set forth in the specification are to be used for claim construction purposes.").

Rather than accept these express definitions as the MPEP and decisions cited above require, the Final Action draws a novel and unsupported distinction between the specification and the claims. Paragraph 25 of the Final Action, notes "For purposes of the *specification*, the term 'customer' will be understood as noted above. For purposes of the *claims* however, the term 'customer' will be given its broadest reasonable interpretation. (Emphasis in original). This conclusion is based on the premise that the claims are somehow not part of the specification. This, of course, is incorrect. 35 U.S.C. § 112, second paragraph. (The *specification* shall conclude with one or more *claims* particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.) This language makes clear that the claims are part of the specification. There are numerous other examples in both the statute and the rules which make clear the claims are part of the specification. In any event, the Final Action cites no authority for the position that having defined a claim term expressly in the specification body, a separate requirement exists for indication of intent to use such meaning when construing the claims. By contrast, the cases cited above and the MPEP generally make abundantly clear that when clear, express definitions of terms provided in the specification are to be used by the USPTO in construing the claims. To the extent that the Final Action finds Applicant has not shown the required intent by his own lexicographer for any claim terms (Final Action para. 26), this finding is erroneous and should be reversed by the Board.

**When the proper definitions of claim terms are used, the combination of Roberts et al. and Brockman et al, even if proper in the first instance does not meet each and every limitation of claim 1 as is required for a *prima facie* case of obviousness.**

The Final Action does not expressly apply the teachings of the these references to the limitations of Claim 1. Rather, the Office Action of December 16, 2003 Paragraph 3 (should be paragraph 2) is incorporated by reference. This referenced language makes clear that the rejections over Roberts et al. in view of Brockman et al. are premised on the assumption that "the customer purchasing the goods could play a variety of roles

(consumer of goods, seller of goods, transporter of goods, etc.).” Brockman et al. is cited for the teaching of product information including consumer sales projection information.

Claims 1-9 and 14 of the present invention require providing an interface to a plurality of **customers**. As both the specification and claim 1 expressly recite, a customer in this context is a purchaser of goods for subsequent resale to consumers. The term customer as used in the Roberts et al. patent is not the same as the term customer in Claim 1. The cited portion of Roberts et al. discloses nothing about **customer** sales information, it relates to **consumer** sales information. In the Amendment transmitted on September 11, 2003, this was made clear by expressly defining in Claim 1 that a customer is a purchaser of goods for subsequent re-sale to consumers. This feature is not present in Roberts et al, and the cited sections of Brockman et al. do not make up for this deficiency. The incorporated second final action (incorporated into the Final Action under review in this appeal) glosses over this distinction between the claimed invention and the prior art by one sentence on Page 2 stating: “Furthermore, it would be obvious to one skilled in the art that the customer purchasing the goods could play a variety of roles (consumer of goods, reseller of good, transporter of goods, etc.).” This summary conclusion, however, is without support in the analysis in the final action or any teaching cited to in the record. Furthermore, the proper analysis for obviousness requires a comparison of the claimed invention as a whole to the prior art as a whole. It is not proper to reduce the combination of prior art references to a series of differences and conclude (without analysis) that the differences themselves would be obvious.

In the instant case the importance of the distinction between Claim 1 being directed to purchasers of goods for re-sale, and a patent publication not so directed becomes important when considering the desirability and result of attempting to modify this teaching with those present in Brockman et al. Having assumed away this key difference between Claim 1 and Roberts et al., the final action goes on to look to Brockman et al. for missing teachings. Among the missing teachings for which Brockman et al. is relied upon is the requirement that the method provide information which customer customized information which includes consumer sales projection information calculated with respect to a given customer (Claim 1, element (e)). Column 4, lines 47+ and the abstract lines 15+ are cited in the final action as supposedly



supplying this missing teaching. This reading of Brockman et al., however, is misplaced. The combination here is inappropriate in light of the earlier articulated difference between Claim 1 and Roberts et al.

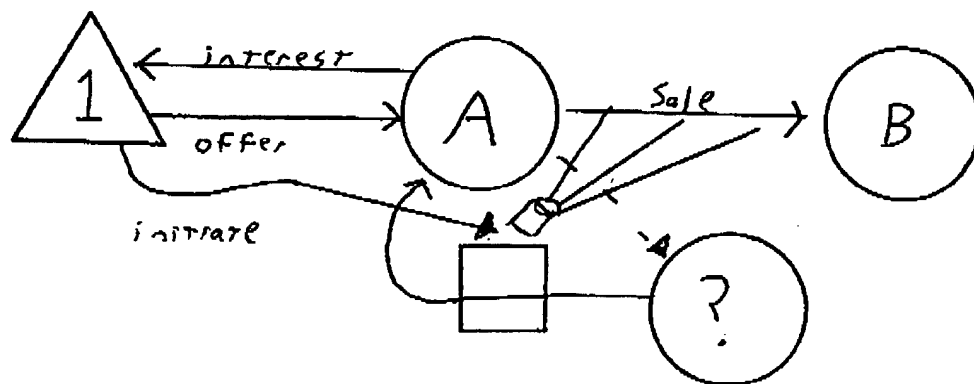
Firstly, it is noted that Brockman et al. deals with an interface for car dealerships to access databases of past customers, repeat customers, and "hot prospects." This allows car salespersons to know some more background about potential car buyers on the lot. The final action assumes (without reasoning for this conclusion) that this information is the same as the claimed consumer sales projection information required by Claim 1. Such is not the case. It is clear that Claim 1 is about providing the interface to the **customer**. Therefore, the **customer** (i.e. the purchaser of goods for re-sale) is the "user" of the system. The information required by Claim 1 is directed to customized information regarding the **re-sales** of the good (i.e. consumer sales projections calculated with respect to the **customer**). At best, the system of Brockman et al. merely identifies to its user the who has purchased a car before, and who has been on the lot before – this does not quantify projected sales information of the user of the system (i.e. the customer) in the manner claimed in Claim 1. This difference highlights one of the problems with the failure to acknowledge properly the fact that even the base reference (Roberts et al.) does not address the claimed context of the purchaser of goods for re-sale to others. Because Roberts et al. does not disclose this feature, there is no motivation to look to Roberts in the manner relied upon in the final action. Additionally, the mere grafting of a few sentences from Brockman et al. does not result in a method disclosing all elements of Claim 1 as a whole.

The referenced final action on page 4 concludes that "information such as the percentage likelihood of consummating the sale successfully" is sales projection information. While this might be a "sales projection" in the generic sense, this is not the particular type of sales projection information required by Claim 1. As noted, the claimed sales projection information is based on information about the **buyer** (customer) who is selling to **others**. Brockman et al. at best predicts the likelihood of a single sale based on information about the buyer of the product itself. There is no calculation of any "downstream" element. An example of the difference helps make the point. The present method allows the provider of the interface to provide it to consumers of several types

(for example, a drug store and a grocery store). A particular consumer good might be expected to achieve a different market share in each of these types of stores (or in different regions, climates, etc.). The present method does not concern itself with the likelihood of the **customer** (who is the "user" of the system in this case) purchasing a given good. The sales projection information is useful to the customer because it gives a projection of his sales to **others** calculated based upon information about **him** (e.g. store type, location, product type, etc.).

It is appreciated that claim terms such as "customer" and "consumer" are similar and in some circumstances a particular person or party could be either a consumer or customer. Nevertheless,, it is clear from Claim 1, that both consumers and customers are relevant parties to the claim and in a given **particular case** are distinct groups. In other words, the claimed flow of information and the frame of reference with respect to calculation and information flow must be maintained once the initial identification of customer or consumer is made.

The diagram below may be helpful in illustrating the features of Claim 1:



The triangular block labeled "1" is a representation of the frame of reference of the provider of the system or the person practicing the claimed method.

The circle labeled "A" is the **customer**.

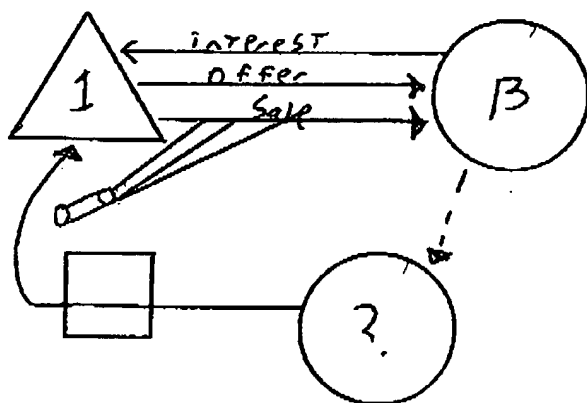
The circle labeled "B" is the **consumer**.

The circle with the "?" is the claimed database.

The dotted line represents accessing of database information. The square represents the claimed calculation.

The spotlight with light beams presents the information provided in step (e). In particular it is important to note **which transaction** this information pertains to. Even assuming the combination of Roberts and Brockman or Roberts and Peterson is proper in the first instance (which is expressly not conceded), the resulting combination does not teach or suggest all elements of Claim 1.

The diagram below represents a system that would result from the combination of Roberts and Brockman, even assuming the propriety of this combination.



All of the symbols in this diagram have the same meaning as explained above. As can be seen the **transaction** about which sales information is provided is the sale to the **customer**, not to the **consumer**. Even if one allows that the consumer can be put in the place of the customer, there is a transaction missing and there is an information flow based upon a claimed calculation missing. In other words, even if the consumers of Roberts and Brockman could properly be considered customers, for purposes of the claim, (i.e. "B" could be "A") the diagram above would result and the information pertaining to the sales to **consumers** would still be missing. Claim 1 requires **both a consumer and customer**. The items being on sales does not render inherent that information provided about that sale will be pertinent to the **claimed relevant transaction** (i.e. that between the purchaser/user of the system and a downstream buyer). Additionally, as shown, Roberts and Brockman both deal with sales projection information of the provider of the system (i.e. triangle "1"). By contrast, Claim 1 requires that this information pertain to the **customer** (circle "A").

As shown in the above diagrams the claimed invention differs fundamentally from the prior art in that the invention provided pertains to a **wholly different transaction**.

The fact that that prior art shows similar information pertaining to wholly different transactions does not make Claim 1 as a whole obvious in light of this art.

The Final Action makes no attempt to address these differences between the prior art and the claimed invention. Rather, the Final Action draws the conclusion that the Applicants' argument is premised upon an incorrect construction of the terms "customer" and "consumer" – a conclusion that is only reached by ignoring the definitions of these terms given in the specification. When the definitions used in the specification for these claim terms are considered, it is apparent that the overall system and transaction claimed in Claim 1 is different from that shown in Roberts et al. in view of Brockman et al. as illustrated above. Therefore, because the Final Action does not properly make out a *prima facie* case of obviousness with respect to Claims 1-9 and 14 over Roberts et al. in view of Brockman et al. when using a proper claim construction, these rejections should be reversed.

## II. CLAIMS 1-9 AND 14 ARE NOT ANTICIPATED UNDER 35 U.S.C. § 102(e) BY PETERSON ET AL. (US PATENT NO. 6,324,522).

The Final Action alleges generally on Page 4 (Paragraph 8) that "the various information provided" in Peterson et al. satisfies the limitations of Claim 1 pertaining to providing product information to consumers. There is no analysis in the Final Action demonstrating that this is the case. Claim 1 specifically requires that the product information provided be customized on the basis of customer information and that the information provided comprise **consumer** sales projections calculated with respect to the **customer**. There is no indication in the Office Action how Peterson et al. satisfies either limitation.

It appears that Peterson et al. is directed to a network of vendors (which are admitted to be analogous to **customers** as that term is used in Claim 1). However, the vendors of Peterson et al. communicate information about product inventory. There is no indication that the information about the product itself provided to the **vendor** is customized on the basis of **vendor information (or customer information)**.

Additionally, there is no indication in Peterson et al. that the information comprises any **consumer** sales projection information as is required by Claim 1. As the Final Action has not demonstrated that each and every element of Claim 1 is disclosed in Peterson et al. this rejection is improper.

In response to Applicants' arguments, the Final Action concludes (Paragraphs 19 and 21) that the customer identification (such as a vendor number) is unique to a given vendor. When such a vendor receives requested information about a product, such information is by necessity "customized." This conclusion, however, is not a reasonable interpretation of the requirements of Claim 1. Claim 1 expressly requires communication to the customer of information which is customized on the basis of customer information from a pre-existing database (such as geographic location and store type). The Final Action essentially ignores this limitation by assuming it is a given that a vendor of say watches will only ask for and receive information about watches while a vendor of radios will only request and get information about radios. Even if this is true, however, the information so requested is in no way "customized on the basis of customer information" as is required by the claims. An information desk giving a pre-printed brochure about a particular hotel only to those visitors who request it is not providing "customized" information about the hotel. The same information is always provided, albeit not to every visitor. Claim 1, however, expressly requires indication of purchase interest in at least one consumer product on the part of the customer. It is **this information** (i.e. information about the already selected product) which is then required by the claim to be customized. The act of selecting which product to receive information about has already occurred and cannot be regarded as "customization" within the meaning of the claims.

Additionally, the Final Action has essentially ignored the limitation of calculation of consumer sales projection information calculated with respect to the customer as will be demonstrated in greater detail when discussing the rejections under 35 U.S.C. § 112.

The Final Action does not show how the Peterson et al. reference teaches or discloses each and every element of Claims 1-9 and 14 – but rather reads the claim terms so generically as to deprive them of any real meaning (much less their plain and ordinary meaning). Only with this unreasonably generic reading of the claim terms can the Final Action conclude that all of the elements of Claims 1-9 and 14 are taught in the Peterson et al. patent. Because this is not the case, the rejection under 35 U.S.C. § 102(e) over Peterson et al. of claims 1-9 and 14 is improper and should be reversed.

**III. CLAIMS 1-9 AND 14 ARE NOT OBVIOUS UNDER 35 U.S.C. § 103 OVER PETERSON ET AL. (US PATENT NO. 6,324,522).**

Claims 1-9

The § 103 rejections over Peterson et al. are made in the alternative to the § 102 rejections. While these rejections under § 103 apply to each of Claims 1-9 and 14, the Final Action contains no further analysis in addition to the § 102 analysis pertaining to any claim, except for Claim 14. Therefore, this Appeal Brief will address the Final Action's application of the Peterson et al. patent to Claim 14 and rely on the discussion above pertaining to anticipation analysis as equally applicable to the obviousness analysis. Applicant notes, however, that the Final Action makes no attempt to show how the teachings of Peterson et al. would be modified (or where such motivation would come from) to support an obviousness rejection of Claims 1-9 if the anticipation rejections of Claims 1-9 are reversed.

Claim 14

Claim 14 expressly requires that the sales projection information is customized on the basis of planned promotional activities with respect to the consumer product. The Final Action takes the primary position that such limitation is inherent by virtue of the product being on sale. This conclusion is not correct, however. An item on sale does not necessarily have any planned promotional activity associated with it – much less inherently have a customized calculation made on the basis of both customer information and promotional activity regarding the product. The Final Action simply dismisses the claim limitations as “nonfunctional descriptive material” while arriving at the summary conclusion that substitution in Peterson et al. of any particular type of information would be obvious. This showing is well short of the requirements showing how the particular relationships among the parties claimed are suggested in Peterson et al.

The Applicant does not necessarily disagree with the Examiner that web based electronic commerce systems are well known in the art. The claimed invention, however, is about a method for streamlining a very particular set of transactions and customizing particular information flows. The parties involved here are retail customers who are engaged in the business of both purchasing and selling products to consumers. The information is customized in particularly claimed ways pertinent to the parties'

relationship to one other. By failing to give the claim terms such as “customer” and “consumer” their expressly defined meanings, the Final Action reduces the claim to a generic basic system for selling goods electronically. The Applicant has never argued, nor attempted to claim, such a generic method. The Applicant simply seeks to have the Examiner accord the claim terms their expressly given meanings, and examine them on that basis. In the absence of a showing of all of the features of the claimed method in the prior art when the terms are properly construed, the claims should be allowed.

**IV. CLAIMS 1-9 AND HAVE NOT BEEN PROPERLY REJECTED UNDER 35 U.S.C. § 112, SECOND PARAGRAPH AS INDEFINITE.**

All of the rejections under 35 U.S.C. § 112, second paragraph stem from the recitation of the limitation in Claim 1 “calculated with respect to at least one of said customers.” The Final Action takes the position that this renders the claims indefinite because one of ordinary skill in the art would not be able to ascertain how the consumer sales projection information is calculated.

These rejections are not properly made. The Final Action merely states a conclusion of indefiniteness without any analysis or support for this conclusion. The central test under the definiteness requirement is that the claims set out with a **reasonable** degree of clarity and particularity the claimed subject matter. An indefiniteness rejection requires the examiner to take into account the content of the particular application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art. MPEP §2173.02. In the instant case, there is no showing that one of skill in the art would not understand the claim term at issue when interpreted in light of the specification.

By contrast, the Final Action maintains that these claims are indefinite on their face citing only MPEP § 2111.01 (requiring construction of claims according to broadest reasonable meaning or “plain meaning” unless they are defined in the specification). The response in the Final Action to Applicant’s last remarks (paragraphs 15 – 19) on this topic makes clear that the definiteness rejections essentially stem from the earlier discussed dispute about what meaning claim terms such as “customer” and “consumer” are to have. The Final Action appears to base the conclusion of indefiniteness on the claim term “calculated with respect to at least one of said customers” as duplicative and,

therefore, unclear. Paragraph 19 of the Final Action analogizes this language to language in a claim stating "the square having four corners." Even if such a recitation could serve as the basis for a § 112, second paragraph rejection, this situation is not factually present in the instant claims. The language here simply means that the required sales projection information is calculated with respect to the earlier recited customer using the system (i.e. the at least one of said customers recited in step (b)). The claims require the provision of information pertaining to **consumer sales projections** (i.e. how many units are projected to be purchased by consumers). Step (c) of the claim requires this information to be calculated with respect to the **customer** (in other words how many units will I, the customer, sell to consumers).

The claim terms in context then simply mean that the sales projections are calculated for a given customer and product and not for the product generally. This does not necessarily always have to be the case (as the Final Action implicitly concludes). The system could have simply calculated sales projections overall for each product and provide that to each customer. The claimed invention, by contrast, requires that this projection information be calculated with respect to a particular, given, customer (i.e. not all customers in the aggregate). As such, the claim limitation has meaning and must be considered.

These terms are not so ambiguous that one of ordinary skill in the art could not ascertain their meaning. Indeed, most of the terms are expressly defined in the specification, and the remaining terms are described in great detail with specific examples. The Final Action ignores the specification completely, ascribes the claims unsupported "ordinary meanings" and then rejects them as unclear. Because it is error, to ignore the specification wholesale in this manner, these rejections are improper and should be reversed.

#### SUMMARY

Claims 1-9 and 14 have not been properly rejected in the Final Action for all of the reasons discussed above. In particular, the rejections under 35 U.S.C. § 112, second paragraph, and under 35 U.S.C. § 102 and § 103 are improper and should be reversed. These rejections all appear from a failure to accord claims terms the express meanings provided for them in the specification during examination. When these meanings are properly considered, as shown above, the claims properly define over the cited prior art



and are sufficiently clear to meet the statutory requirements. As such, the rejections should be reversed by the Honorable Board of Appeals and Interferences.

Respectfully Submitted,

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CLAIMS APPENDIX (Serial No. 09/931,358)

1. A method comprising the steps of:
  - a) providing an interface to a plurality of customers, wherein said customers are purchasers of goods for subsequent sale to consumers,
  - b) receiving customer identification information from at least one of said customers, said receiving being accomplished through the use of said interface,
  - c) receiving from at least one of said customers an indication of purchase interest in at least one consumer product, wherein said at least one consumer product is selected by said at least one of said customers from a plurality of consumer products available for sale, wherein the identity of said plurality of consumer products is made known to said plurality of customers through the use of said interface,
  - d) accessing customer information related to said at least one of said customers from a pre-existing database,
  - e) providing to said at least one of said customers product information regarding said at least one consumer product through the use of said interface, wherein said product information provided is customized on the basis of said customer information accessed in step (d), and wherein at least some of the product information provided comprises consumer sales projection information calculated with respect to said at least one of said customers.
2. The method of Claim 1 wherein said interface is provided on one or more programmable computers.
3. The method of Claim 1 wherein said interface is a graphical user interface.
4. The method of Claim 1 wherein said interface provided via the world wide web.
5. The method of Claim 1 wherein said indication of purchase interest in accomplished through the use of representative icons.

6. The method of Claim 1 wherein said pre-existing database comprises sales information with respect to said plurality of customers.
7. The method of Claim 1 wherein at least steps (d) and (e) are accomplished through the use of a pre-programmed relational database.
8. The method of Claim 1 wherein the product information provided in step (e) is customized on the basis of customer type.
9. The method of Claim 1 wherein the product information provided in step (e) is customized on the basis of customer specific characteristics.
14. The method of Claim 1 wherein said sales projection information is customized on the basis of planned promotional activities with respect to said at least one consumer product.